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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/309,831	05/11/1999	THOMAS C. MIELENHAUSEN	90021-3	8013
32300 7590 08/09/2007 BRIGGS AND MORGAN P.A. 2200 IDS CENTER 80 SOUTH 8TH ST MINNEAPOLIS, MN 55402			EXAMINER HUYNH, CONG LAC T	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/309,831

Applicant(s)

MIELLENHAUSEN, THOMAS C.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed 3/16/07 after the affirmation decision of the Board of Patent Appeals and Interferences dated 9/29/06 to the application filed on 5/11/99.
2. Claims 1-22 are pending in the case. Claims 1, 15, 17 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, it does not make sense that the abbreviation can be inserted at any position in the existing text in the limitation "inserting the abbreviation into the pre-existing text at a position selected by the user at any position in the existing text." The insertion of abbreviation can be carried out *only at the position of a word having a corresponding abbreviation*. At other positions of other words that do not have corresponding abbreviations, such insertion appears improper.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ichbiah (US Pat No. 5,623,406, 4/22/97, filed 3/6/95) in view of Goldwasser (US Pat No. 5,096,423, 3/17/92, filed 12/29/87).

Regarding independent claim 1 and its dependent 9-10, Ichbiah discloses:

- storing in the memory a second data structure encoding a plurality of abbreviations and corresponding words (col 4, lines 53-67: a glossary of abbreviations and the corresponding words and phrases is stored in the system; col 5, line 25 to col 6, line 18; abstract: "retrieving words and phrases from abbreviations" inherently shows there is a list of abbreviations and corresponding words and phrases for retrieving)
- displaying a list of suggested words and phrase corresponding to the selected abbreviation, and receiving input from the user to choose the desired word and phrase for the abbreviation (col 4, lines 53-67: the fact that multiple matching words and phrases for a proposed abbreviation are displayed by the system in the form of option in advisory table upon the entry of characters into the system shows displaying a list of suggested words and phrases for an abbreviation for selecting; col 12, lines 42-67: more than one choice of matching words are displayed to users for selecting)
- actively selecting an abbreviation in the text to be converted to a word and

converting the abbreviation to a word or phrase (col 6, lines 10-60 and col 5, lines 16-18, line 25 to col 6, line 38: the entered data in the form of abbreviation is selected to be converted to corresponding phrase using the data in the glossary; in other words, selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure is performed; it is also noted that typing a word for selecting that word in the text to be converted is actively selecting since it is an user's action of selecting in the form of data typing)

Ichbiah does not explicitly disclose:

- storing in the memory a first data structure encoding a plurality of words and corresponding abbreviations
- selecting a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation

Goldwasser discloses:

- storing in the memory a first data structure encoding a plurality of words and corresponding abbreviations (col 5, lines 27-33: storing the sequences of keypresses, which are long sequences of characters of words, and the correspondent abbreviations, both are formed a first data structure as claimed)
- actively selecting a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using said data structure (abstract; col 2, lines 39-64; col 4, line 28 to col 5, line 11: recognizing the sequence of keypresses typed of a word that has a corresponding

abbreviation and converting the keypresses into a corresponding abbreviation according to the stored list of words and corresponding abbreviation; said recognizing inherently indicates that said word in the entered text is selected for converting to abbreviation based the stored list in memory; it is noted that selecting a word by typing a word is actively selecting since it is a user's action of selecting)

- replacing the word with the corresponding abbreviation (col 2, line 50 to col 3, line 55: by typing a number of letters then the menu of corresponding abbreviations is displayed to user; user then choose one of the displayed linguistic expressions rather than type it out; the fact that by selecting the word or phrase from the menu, the user *can add this word or phrase to the text* according to Pointwriter method, by analogy, shows that a word is replaced with a corresponding abbreviation selected from the menu)

In addition, Ichbiah and Goldwasser do not state explicitly that the text for selecting a word or selecting an abbreviation is a pre-existing text.

However, it would have been obvious to an ordinary skill at the time of the invention was made to have recognized that the text used for these selecting is a pre-existing text since the words or the abbreviations included in the text are known in advance so that there are corresponding abbreviations and words ready for them to be replaced.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Goldwasser into Ichbiah to obtain converting from a word and phrase to a corresponding abbreviation and converting from an abbreviation to a

corresponding word and phrase since Goldwasser provides the first method and Ichbiah provides the second method where both are to help users fast finding a right word or a right abbreviation in writing documents.

Regarding claims 2 and 16, Ichbiah discloses editing, updating and customizing the data structures, which are words and corresponding abbreviations (col 7, line 55 to col 8, line 47; col 14, lines 3-27; col 11, line 35 to col 12, line 40). Lu also discloses these features (col 3, lines 17-36; col 5, lines 20-68).

Regarding claims 3-6, Ichbiah discloses that the word or an abbreviation is selected by a user using a keyboard command or using a mouse (col 3, lines 63-65; col 6, line 53 to col 7, line 3; col 12, line 60 to col 13, line 5; col 14, lines 29-58).

Regarding claims 7-8, 11-12, Ichbiah discloses:

- displaying a list of suggested abbreviations corresponding to the selected word and receiving input from the user to choose the desired abbreviation (col 5, lines 15-60)
- scanning the text for abbreviations to be converted to words or phrases and converting the abbreviation selected by the data processing to corresponding word (col 5, lines 16-24; col 6, line 33 to col 7, line 3; col 14, line 29 to col 15, line 55: recognizing an entry of abbreviation for a corresponding word or phrase based on the glossary of words and abbreviations implies scanning the entered

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text for a corresponding word or phrase; col 12, line 42 to col 13, line 20:

converting the abbreviations to corresponding words or phrases by input

command from a user)

- receiving input from the user to choose the desired abbreviation corresponding to the phrase or to choose the desired phrase corresponding to the abbreviation (col 12, line 42 to col 13, line 20)

Ichbiah does not explicitly disclose:

- displaying a list of suggested words and phrases corresponding to an abbreviation
- scanning the text for words to be converted to abbreviations and converting words selected by the data processing to corresponding abbreviation
- replacing the words in the text with the corresponding abbreviations

Goldwasser discloses:

- a list of suggested words and phrases corresponding to an abbreviation (col 3, lines 8-37: providing a menu of linguistic expressions of words and phrases having corresponding abbreviation for users to select one)
- scanning the text for words to be converted to abbreviations and converting words selected by the data processing to corresponding abbreviation (col 2, line 50 to col 3, line 55: recognizing the entry data of a word for a corresponding abbreviation implies that the text is scanned for a word to be converted to an abbreviation)
- replacing the word with the corresponding abbreviation (col 2, line 50 to col 3,

line 55: by typing a number of letters then the menu of corresponding abbreviations is displayed to user; user then choose one of the displayed linguistic expressions rather than type it out; the fact that by selecting the word or phrase from the menu, the user *can add this word or phrase to the text* according to Pointwriter method, by analogy, shows that a word is replaced with a corresponding abbreviation selected from the menu)

Ichbiah and Goldwasser do not state explicitly that the text for selecting a word or selecting an abbreviation is a pre-existing text.

However, it would have been obvious to an ordinary skill at the time of the invention was made to have recognized that the text used for these selecting is a pre-existing text since the words or the abbreviations included in the text are pre-existing so that there are corresponding abbreviations and words ready for them.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Goldwasser into Ichbiah to obtain converting from a word and phrase to a corresponding abbreviation and converting from an abbreviation to a corresponding word and phrase since Goldwasser provides the first method and Ichbiah provides the second method where both are to help users fast finding a right word or a right abbreviation in writing documents.

Regarding claims 13-14, Ichbiah discloses selecting an abbreviation from the first data structure (abstract; col 3, lines 50-65), and selecting an abbreviation from the second data structure (col 4, line 53 to col 5, line 60). Ichbiah also discloses that when typing

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the abbreviation, the corresponding phrase is inserted in the displayed text (figure 3; col 14, line 28 to col 15, line 27). This shows that a phrase or word corresponding to a selected abbreviation is inserted into the text at a position selected by the user and said insertion is performed at any position in the text where a word has a corresponding abbreviation.

Ichbiah does not disclose that the text is a pre-existing text.

However, it would have been obvious to an ordinary skill at the time of the invention was made to have recognized that the text used for these selecting is a pre-existing text since the words or the abbreviations included in the text are pre-existing so that there are corresponding abbreviations or words ready for them to be replaced.

Independent claim 15 includes the same limitations as in claims 1, 9-10, and 13-14, and is rejected under the same rationale.

Independent claim 17 and its dependent claim 22 are for a data processing apparatus for performing the method claims 1, 9-10, and 13, and are rejected under the same rationale.

Claims 18-22 are for a data processing apparatus of method claims 7-8, 11-12, and are rejected under the same rationale.

Response to Arguments

7. Applicant's arguments filed 3/16/07 have been fully considered but they are not persuasive.

Regarding independent claim 1, Applicants argue that the references do not teach or suggest all the claim limitations, specifically do not disclose the step "actively selecting a word in the pre-existing text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using the first data structure, and replacing the word with the corresponding abbreviation.

Examiner respectfully disagrees.

Ichbiah discloses that the entered data in the form of abbreviation is selected to be converted to corresponding phrase using the data in the glossary (col 6, lines 10-60 and col 5, lines 16-18, line 25 to col 6, line 38). In other words, selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure is performed. It is also noted that typing a word for selecting that word in the text to be converted is actively selecting since it is an user's action of selecting in the form of data typing, and the typed word is a word selected from among other words in the glossary.

The text of the words or abbreviations is also a pre-existing text since the words or the abbreviations included in the text are known in advance so that there are corresponding abbreviations and words ready for them to be replaced.

Applicants argue that Goldwasser does not disclose replacing the word with the corresponding abbreviation since the abbreviation is merely displayed as text in addition to the corresponding word.

Examiner respectfully disagrees.

Goldwasser applies the Pointwriter method (col 2, lines 56-64) which means that when the abbreviations are displayed the in a menu in form of linguistic expressions, then a user can select one in the displayed menu to add to the text. In other words, the word is replaced with a corresponding abbreviation selected from the displayed menu.

Regarding claims 3-6, Applicants argue that Ichbiah does not select a word in the pre-existing text to be converted to an abbreviation using a keyboard or a mouse.

Examiner respectfully disagrees.

Since Ichbiah discloses typing a word and this word is converted into an abbreviation, Ichbiah discloses selecting a word using a keyboard.

Regarding claim 7, Applicants argue that the references do not disclose scanning the pre-existing text for words to be converted to abbreviations and replacing words with abbreviations.

Examiner respectfully disagrees.

Goldwasser monitors the letters of a word entered by a user and an abbreviation for that word is displayed if there is a corresponding abbreviation (col 2, line 50 to col 3, line 55). That means Goldwasser monitors the text, which is the word having an

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abbreviation known in advance by the system database, for words to be converted to corresponding abbreviations. In other words, Goldwasser discloses scans the pre-existing text for words to be converted to abbreviations.

Goldwasser further discloses replacing the word with the corresponding abbreviation (col 2, line 50 to col 3, line 55: by typing a number of letters then the menu of corresponding abbreviations is displayed to user; user then choose one of the displayed linguistic expressions rather than type it out; the fact that by selecting the word or phrase from the menu, the user *can add this word or phrase to the text* according to Pointwriter method, by analogy, shows that a word is replaced with a corresponding abbreviation selected from the menu).

Regarding claims 13 and 15, Applicants argue that Goldwasser does not teach the capability of inserting an abbreviation in previously entered text at any position in the previously entered text.

Examiner respectfully disagrees.

As mentioned above, Goldwasser discloses replacing a word with a corresponding abbreviation by selecting it from a displayed menu. Such replacing implies that inserting the corresponding abbreviation at any position of the word, which is a previously entered text, in the text is carried out.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ahmad et al. (US 6,172,675).

Kim et al. (US 2002/0169770).

Mielenhausen (US 2003/0115213).

Govindugari et al. (US 2004/0083199).

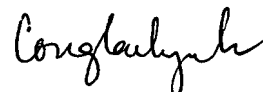
Ljubicich et al. (US 2006/0112133).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
8/3/07